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Examiner Keasel, E.
Art Unit 3754

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Art Unit 3754

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BRIEF ON APPEAL

The real party in interest is Belimo Air Control (USA) Inc.

I hereby certify that this paper is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington D.C. 20231

A. Okrentowich 5/23/02
A. Okrentowich Date

(2) Related Appeals and Interferences

There are no related appeals or interferences.

(3) Status of Claims

Claims 1-42 are pending in this application.

Claims 10-42 are under appeal.

Claims 1-9 have been allowed.

This is a reissue application which was filed for the purpose of provoking an interference with U.S. Patent 5,937,890, referred to herein as the '890 patent. Claims 1-9, which are the claims from Applicants' original patent, U.S. Patent 6,039,304, referred to herein as the '304 patent, stand allowed. The claims copied for the purpose of provoking an interference have all been rejected.

(4) Status of Amendments

No amendment has been offered after the final rejection.

(5) Summary of Invention

The present invention is directed to control valves in which flow capacity may be easily varied and controlled. In one embodiment, the invention involves a ball valve (FIG. 1, 3) and a disk (FIG. 2, 8), wherein the disk has a specially shaped opening (FIG. 3, 10), such that the opening in the disk interacts with the passage through the ball valve (FIG. 1, 4) in such a way that desired flow characteristics are achieved. See col. 4, lines 37-45. For example, by use of an

appropriately shaped opening in the disk, it is possible to achieve equal percent flow through the passage in the valve as the ball is turned from an open to a closed position. See col. 6, lines 18-19.

(6) Issues

1. Whether new matter rejections under 35 U.S.C. §112 are proper when the purported new matter involves immaterial limitations contained in claims which have been copied for the purpose of provoking an interference with an issued patent.

2. Whether it is appropriate to apply the recapture doctrine to support the rejection of pending claims in a Reissue Application when such claims are broader in ^{some ?} same respects and narrower in other respects than are the claims in an applicant's issued patent.

3. Whether it is proper to reject claims which have been copied from an issued patent for the purpose of provoking an interference over prior art solely for the purpose of avoiding the declaration of an interference.

(7) Grouping of Claims.

The invention is claimed from several perspectives -- each defining the invention in different terms. The claims do not stand or fall together. Indeed, the Office Action places the claims in four separate groups:

A. Claims 10-17, 19, 20, 22 and 24-42, have been rejected under 35 U.S.C. § 251 as being based on new matter added to the patent for which reissue is sought; this same group has been rejected under 35 U.S.C. § 112 first paragraph as containing subject matter not supported in the specification.

B. Claims 18, 21 and 23, have been rejected under 35 U.S.C. § 251 as being an improper recapture of subject matter surrendered in the application for the patent upon which the present reissue is based.

C. Claims 39 and 40 have been rejected under 35 U.S.C. § 102(b) as anticipated by Scaramucci, U.S. Patent 3,542,338.

D. Claims 18, 21, 23, 24 and 25 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Scaramucci, U.S. Patent 3,542,338.

Since the Examiner's position as to the claims of Group A above, is that those claims lack support in the specification, those claims must of necessity be considered on a claim-by-claim basis. As to the remaining three (3) claims (Group B, above), since those claims are being rejected based on improper recapture of surrendered subject matter, those claims too must be considered on a claim-by-claim basis.

7. Argument

A. **The New Matter Rejections of Claims Based on Immaterial Limitations Not Relevant to Patentability is Improper Where Such Claims Have Been Copied to Provoke an Interference.**

As to the claims which are deemed to contain new matter, (claims 10-17, 19, 20, 22 and 24-42) the Examiner has identified certain limitations in these claims which he contends are lacking in Applicants' specification. The claim terminology, the claim in which such terminology is found, and Applicants' position regarding the support for such terminology is set forth below:

- i) "the connector on the insert member" - (claim 10) see Figure 8 and the flange (unnumbered) on disk 8. While not the sole connector, and used in conjunction with another means, this flange is equivalent in its function as a connector with the embodiment depicted in Fig. 6 of the '890 patent, wherein element 318, a volume control insert, relies on external means (not shown) for connection.
- ii) "the insert member attached to the valving member" (claims 10, 19) - While not literally shown, this is a feature not patentably distinct (and therefore not material) from the embodiment in Applicants' disclosure wherein the attachment of the insert member is to the valve body.
- iii) "the insert member attached to the valve seat" - (claim 31) Again, while not literally shown, this is a feature not patentably distinct (and therefore not material) from the embodiment in Applicants' disclosure wherein the attachment is to the valve body.

- iv) "the insert member having a parabolic opening" (claim 17) - Applicants' description describes the insert opening being shaped to achieve "equal percent" flow characteristics: the same effect achieved by the '890 patent with its "parabolic" opening. The '890 patent itself does not illustrate a true parabolic curve and in its description indicates that the opening is "parabolic in that the height h of opening 246 (Fig. 5B) changes across its width w, unlike the oblong opening 146 (Fig. 4) which has a substantially constant height. Similar to the oblong opening 146 above, the parabolic opening 246 provides improved volume control over a conventional ball valve, and in particular provides an equal percentage flow characteristic which is preferred in automatic temperature control systems." (col. 7, lines 3-10)
- v) "the valving member being formed from brass or stainless steel" (claim 24) - Again, these limitations are not material to patentability. Moreover, these are conventional materials and are understood by those skilled in the art to be included in any description of valving materials. Note the Examiner himself agrees that the choice of materials is within the general skill of a worker in the art, Office Action of December 19, 2000, at page 7, paragraph 1.
- vi) "the insert members are made of plastic" (claims 10 and 25) - Again, these limitations are not material to patentability and are understood by those skilled in the art to be included in any description of valving materials, especially where the disclosure calls for a "semi-resilient material" (col. 5, line 66). Note the Examiner himself agrees that the choice of materials is within the general skill of a worker in the art, Office Action of December 19, 2000, at page 7,

paragraph 1.

- vii) "the inserts having a diameter corresponding to the diameter of the bore of the valving member" (claim 26) - In this regard, see Fig. 1 of applicants' description, which shows an insert 8 having several diameters, at least one of which has "a diameter corresponding to the diameter of the bore of the valving member".
- viii) "the valving member and connectors of the insert members comprising cooperating legs and pockets" (claims 11 and 32) - Again, these limitations are not material to patentability.
- ix) "a portion of the valve seat extending across the fluid passage and having an elongate opening" (claim 39) - Again, these limitations are not material to patentability.

Applicants respectively urge that the Examiner is applying an improper standard. The Examiner dismisses Applicants' arguments regarding new matter and supporting disclosure by saying that the "argument that a claim limitation should be considered disclosed if not disclosed (but considered obvious) is not persuasive". However, for purposes of provoking an interference, Applicants are routinely permitted to suggest counts (copy claims) which contain limitations not found in Applicants' disclosure, so long as the limitations are not material to patentability. See 37 C.F.R. 1.606. If the Examiner disagrees with Applicants' position as to the presence of supporting disclosure in Applicants' underlying patent for certain of the limitations found in Applicants' copied claims, it is incumbent upon the Examiner to suggest alternative counts. See generally the MPEP at 2305.

As an example of such a count which would be free from the Examiner's rejections/objections, note that pending claim 19 is presently under rejection for the reason that it contains the limitation

"wherein said valving member and said plurality of inserts include a connector for attaching one of said plurality of inserts to said valving member across said bore."

The Examiner argues that this limitation is unsupported by Applicants' specification. Applicants have responded that this limitation does not involve a patentability distinct feature. Note, however, that even if Applicants are not permitted to copy the above quoted claim limitation, present claim 19 without the quoted limitation would constitute a proper interference count.

Similarly, claim 27 with the final limitation

"wherein said valving member and said plurality of inserts include a connector for attaching one of said plurality of inserts to said valving member across said bore; said connector comprising cooperating legs and pockets, said legs and pockets being formed in said valving member and said plurality of inserts"

would also constitute a proper interference count, broader than the corresponding claim in the issued patent yet fully supported by applicants' disclosure, were the quoted limitation deleted.

The claim would then be free from the new matter objection, which is based on what is in Applicants' view a limitation which does not involve a patentable feature.

In interference practice it is common to have a count which is broader than any of the claims in the patent with which an applicant is attempting to provoke the interference. The above are examples of such counts. See generally 37 C.F.R. § 1.606 and 1.607.

The Examiner openly admits that there is overlapping claimed subject matter as between the Mirandi patent claims and at least some of those copied claims in the reissue application. In particular, the Examiner has not rejected claims 18, 21 and 23 under 35 U.S.C. § 112 as containing new matter. Thus, the Examiner clearly concurs with Applicants that for at least these three claims there is support in Applicants' Specification. However, the Examiner has refused to declare an interference as to those claims by contending that those three claims may be rejected based on both the "recapture doctrine" and over prior art.

B. A Recapture Rejection is Improper Where the Claims Involved are Narrower In Some Respects and Broader In Other Respects Than are The Claims In The Issued Patents.

The Examiner has rejected claims 18, 21 and 23 under 35 U.S.C. §251 as being improper recapture of broadly claimed subject matter surrendered during prosecution of the application for the patent upon which the present reissue is based.

In particular, the Examiner asserts that during the prosecution of the '304 patent the Applicants' introduced the following language into what ultimately became claims, 1, 4 and 6:

" wherein at least one of the casing openings forms a groove" and "an internal retaining ring sized and shaped to fit at least partially inside the groove, wherein the disk is retained by internal retaining ring which is at least partially recessed into the groove in one of the casing openings"

Based on the addition of this claim limitation, the Examiner now contends that presently pending claims 18, 21, and 23 are broader in scope than the patented claims because no particulars of the attachment are set forth in these three pending claims. The Examiner contends that the claim limitation "attachable across said fluid passage" in claims 18, 21 and

23 is broader than the detailed recitations of the groove and retaining ring and represents an improper recapture of previously claimed subject matter which was surrendered in the application for the patent upon which the present reissue is based.

However, even if one were to agree that the language in claims 18, 21 and 23 is broader in terms of attachment means than is the limitation now employed in claims 1, 4 and 6, the recapture analysis should not end here.

First, clearly the intent of this Reissue application is to provoke an interference not to recapture a limitation previously inserted in order to obtain the allowance of the '304 patent. Second, claims 18, 21 and 23 contain limitations not found in issued claims 1, 4 and 6. Making claims 18, 21 and 23 narrower in some respects than were the claims which were amended in the original application.

Applicants believe that the recapture doctrine is clearly inapplicable here and is not consistent with the controlling case law. Recapture is intended to preclude an applicant from obtaining reissue claims which are of the same scope as claims which the applicant may have conceded were unpatentable by virtue of amendments made during the prosecution of the issued patent. The leading case explaining and applying the recapture doctrine is *Ball Corp. v. United States*, 729 F.2d 1429, 221 U.S.P.Q. 289 (Fed. Cir. 1984), which was indeed cited and relied upon by the Examiner. A reading of *Ball* makes clear, however that application of the recapture doctrine is unwarranted here.

Applicants amended their claims in now issued U.S. Patent 6,039,304 to insert a claim limitation directed to means for holding in place the disk which controls flow through the ball valve passage. However, the now pending claims, against which recapture is asserted, are not equal in scope to the pending claims to which Applicants added the referenced limitation in the issued patent. Rather, pending claims 18, 21 and 23, against which the Examiner has asserted recapture, are narrower in some respects and broader in other respects than were Applicants' initial claims. *Ball*, as well as the other cases cited by the Examiner, *In re Clement*, 131 F. 3d 1464, 45 U.S.P.Q. 2d 1161 (Fed. Cir. 1997) and *Hester Industries, Inc. v. Stein, Inc.*, 142 F. 3d 1472, 46 U.S.P.Q. 2d 1641 (Fed. Cir. 1998), hold that in such circumstances recapture does not automatically apply.

As explained in *Ball*, the recapture doctrine is intended to prevent Applicants from using the reissue procedure as a substitute for appeal. In other words, Applicants should not, in lieu of appeal, be permitted to cancel claim limitations to secure allowance and then file for reissue to try to secure claims of the original scope. Rather, as *Ball* states, "Reissue is an extraordinary procedure and must be adequately supported by the circumstances...". 221 U.S.P.Q. at 293. The circumstances here are not in dispute. Applicants filed this reissue for the clear and obvious purpose of provoking an interference, not to remove a particular claim limitation from their issued patent.

In *Ball* the CAFC rejected rigid application of the recapture doctrine, and emphasized that recapture was an equitable doctrine, requiring analysis of particular factual situations. In *Ball* the CAFC permitted a reissue applicant to proceed with claims which were narrower in

some respects and broader in other respects than were the claims in the issued patent.

Clearly, Applicants' claims 18, 21 and 23 are claims which the *Ball* Court would not have rejected based on recapture.

Equitable factors here dictate that the recapture doctrine not be applied. In addition to the circumstance that this reissue was filed for the sole purpose of provoking an interference and not to reargue prior art, the prior art here at issue is not even the same art as was applied against Applicants' claims in their original patent application.

Accordingly, the very cases cited by the Examiner on the issue of recapture do not support, and in fact are at odds with, the present recapture rejection.

C. Prior Art Rejections are Improper With Respect To Copied Claims in Situations Where the Patentability of Such Claims is More Appropriately Determined in The Context of an Interference.

As to the prior art rejection, Applicants respectfully urge that it was improper for the Examiner to make the prior art rejection Final, as the Group Director did not approve this rejection in the First Office Action, as is required by Patent Office regulations. MPEP 2307.02. Accordingly, at a minimum, a Final Rejection of claims copied from the Mirandi patent based on the cited prior art is premature. In their Response to the First Office Action applicants' noted that a Final Rejection in view of the prior art would be premature, were it to be contained in the next Office Action.

Regarding the merits of the prior art rejection, Applicants continue to urge that the patentability of the claims copied from the Mirandi patent should be determined in an interference proceeding, which is the most appropriate form for resolving the priority dispute between an issued patent and an application.

CONCLUSION

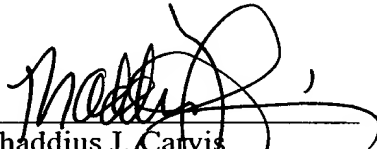
The MPEP at Chapter 2306 is quite explicit:

"In all cases the examiner should keep in mind that the issuance of two patents for inventions which are either identical to or not patentably distinct from each other must be avoided."

In this case, the Examiner has recognized that there is overlapping subject matter as between the claims of the issued patent and certain fully supported claims in the reissue application. It is now improper for the Examiner to grasp for tenuous grounds on which to reject the reissue claims, solely for the purpose of preventing an interference, which proceeding could resolve in an equitable fashion all of the outstanding issues which this reissue application presents.

Respectfully submitted,

Date: 23 May 2002


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